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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200355
Party	Defendant Nextel Communications, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

MOTOROLA MOBILITY, INC., and	)	
MOTOROLA TRADEMARK	)	
HOLDINGS, LLC,	)	
	)	
Opposers,	)	
	)	Opp. No.: 91/200,355
v.	)	App. No.: 78/575,442
	)	Pot. Mark: SOUND MARK
NEXTEL COMMUNICATIONS, INC.	)	
	)	
Applicant.	)	
	)	
SOUTHERN COMMUNICATIONS	)	
SERVICES, INC.	)	
	)	
Opposer,	)	
	)	Opp. No.: 91/200,324
v.	)	App. No.: 78/575,442
	)	Pot. Mark: SOUND MARK
NEXTEL COMMUNICATIONS, INC.	)	
	)	
Applicant.	)	
	)	

**NEXTEL’S MOTION TO CONSOLIDATE OPPOSITION PROCEEDINGS**

Applicant Nextel Communication, Inc.<sup>1</sup> (“Applicant” or “Nextel”) hereby moves to consolidate Oppositions Nos. 91/200,355 and 91/200,324, both of which oppose Nextel App. No. 78/575,442 for the registration of its sound mark.<sup>2</sup> Consolidation is warranted because it will conserve judicial resources and will not prejudice the opposing parties. Nextel contacted counsel for Opposers Motorola Mobility, Inc., Motorola Trademark Holdings, LLC (collectively

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<sup>1</sup> Applicant S-N Merger Corp. assigned the application to Nextel Communications, Inc. in an assignment recorded on March 22, 2006.

<sup>2</sup> This motion is being filed in both Opp. No. 91/200,355 and Opp. No. 91/200,324.

“Motorola”), and Southern Communications Services, Inc. (“Southern”) on August 2, 2012, but, at the time of filing this motion, had not received information regarding whether Opposers consented to this motion.

## **ARGUMENT**

In determining whether to consolidate proceedings, the Board considers “savings in time, effort, and expense . . . against any prejudice or inconvenience that may be caused thereby.” TBMP § 511. Consolidation of the oppositions of Motorola and Southern will result in greater efficiency and will not prejudice either opposing party.

### **A. The Motorola and Southern Oppositions Involve the Same Mark and Overlapping Grounds For Opposition**

Nextel’s application seeks to register a tone at 1800 Hz played at a cadence of 24 milliseconds (ms) ON, 24 ms OFF, 24 ms ON, 24 ms OFF, 48 ms ON (the “Nextel Chirp”) for various telecommunications services. Motorola and Southern’s oppositions (which oppose all services named) significantly overlap, alleging in parallel that the Nextel Chirp cannot be registered because it is a functional alert tone, has not been used as a trademark, has not acquired distinctiveness, and has not been used by Nextel in a substantially exclusive manner. *See* Motorola Opp. at ¶¶ 17, 18, 23, 25; Southern Opp. at ¶¶ 16-20. These grounds are likely to rely on substantially identical evidence regarding Nextel’s use of the mark.

Southern’s opposition contains the additional ground that it has priority to the mark and therefore Nextel’s use would create a likelihood of confusion.<sup>3</sup> Because Motorola claims that Nextel’s use was not substantially exclusive, specifically citing Southern’s use (*see* Motorola

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<sup>3</sup> Motorola’s opposition also includes grounds of fraud and that Nextel had not used the mark as a trademark with respect to every listed service, which Motorola also argues constitutes fraud.

Opp. at ¶ 18), the nature and character of Southern's use will be at issue in the Motorola opposition proceeding as well. By consolidating these oppositions, the Board can conserve time and resources and can adjudicate the common central question – whether the Nextel Chirp functions as a trademark for Nextel's applied-for services – in a single decision. *See S. Industries Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293, 1297 (TTAB 1997) (consolidation granted where both proceedings involved the same mark and “sufficient commonality of factual issues.”).

**B. Neither Motorola Nor Southern Will Be Prejudiced By Consolidating the Oppositions**

These oppositions have similar timelines and therefore, neither Motorola nor Southern will be prejudiced by consolidation. Discovery opened approximately two weeks ago in the Motorola case and is scheduled to open in approximately four weeks in the Southern case. At this early stage, the cases can be consolidated with no resulting prejudice.

**C. If Granted, Nextel Requests that the Southern Schedule Be Adopted**

TBMP Rule 511 instructs that when a motion for consolidation is granted, the Board will reset the dates “usually by adopting the dates as set in the most recently instituted of the cases being consolidated.” The most recently instituted case is Motorola's opposition. After suspending the Motorola opposition and directing the parties to file cross-motions for summary judgment, the Board ruled on the motions and set a case schedule in June 2012, setting the opening of discovery for July 20, 2012. However, during the summary judgment process in the Motorola opposition, the Southern opposition was suspended for settlement negotiations. Nextel has now filed its answer and discovery is scheduled to open on September 2, 2012. To ensure that all parties have a full discovery period, Nextel requests that the Board adopt the schedule set in the Southern case.

## **CONCLUSION**

Nextel respectfully requests that the Board grant its Motion to Consolidate Opposition Nos. 91/200,355 and 91/200,324.

Respectfully submitted,

/s John I. Stewart, Jr.

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August 3, 2012

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing NEXTEL'S MOTION TO CONSOLIDATE OPPOSITION PROCEEDINGS was served on counsel for Opposers this 3rd day of August, 2012, by sending same via e-mail, to:

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/s Ann Mace

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Ann Mace